

Applicants : BERMUDEZ, et al.  
U.S. Serial No.: 10/738,423  
Filed : December 16, 2003  
Page : 2

REMARKS

Claims 100-112 are pending in this application.

Election/Restrictions Requirement

The Examiner to whom this application is assigned indicated that under 35 U.S.C. § 121, restriction to one of the following groups of inventions is required:

- I. Claims 100, 103, 106-108, 111 and 112, are drawn to a method of inhibiting tumor using a chemotherapeutic agent and an attenuated tumor-targeted bacteria, wherein the bacteria is a facultative aerobe or facultative anaerobe, classified in class 424, subclass 93.1.
- II. Claims 101, 102 and 104-112, are drawn to a method of inhibiting tumor using a chemotherapeutic agent and an attenuated tumor-targeted bacteria modified to comprise one or more nucleic acid molecules encoding an effector molecule, wherein the bacteria is a facultative aerobe or facultative anaerobe, classified in class 424, subclass 93.21.

In response, Applicants respectfully traverse the above restriction.

Under MPEP, there are two criteria for a proper requirement for restriction between patentable distinct inventions: (A) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) there must be a serious burden on the Examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - §

Applicants : BERMUDEZ, et al.  
U.S. Serial No.: 10/738,423  
Filed : December 16, 2003  
Page : 3

806.04(i), § 808.01(a), and § 808.02). If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes independent claims or distinct inventions.

Applicants further submit that claims 100-112, Groups I-II, do not require restriction as they are connected by a single relationship, which is a method of inhibiting tumor using a chemotherapeutic agent and an attenuated tumor-targeted bacteria, wherein the bacteria is a facultative aerobe or facultative anaerobe that connects the claims (MPEP § 802.01).

In addition, Applicants maintain that the Examiner would not be seriously burdened by searching and examining all of the pending claims in a single application. A search for a method of inhibiting tumor using a chemotherapeutic agent and an attenuated tumor-targeted bacteria, wherein the bacteria is a facultative aerobe or facultative anaerobe (Group I) will reveal references to a method of inhibiting tumor using a chemotherapeutic agent and an attenuated tumor-targeted bacteria modified to comprise one or more nucleic acid molecules encoding an effector molecule, wherein the bacteria is a facultative aerobe or facultative anaerobe (Group II).

Given the single, searchable relationship, the Examiner would not be seriously burdened by searching and examining the claims of these groups in a single application. (See MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02). Accordingly, Applicants request withdrawal of the restriction of claims 100-112.

Applicants : BERMUDES, et al.  
U.S. Serial No.: 10/738,423  
Filed : December 16, 2003  
Page : 4

Election of Invention

In the event the above discussion does not convince the Examiner to withdraw the restriction requirement, Applicants hereby elect Group I, drawn to a method of inhibiting tumor using a chemotherapeutic agent and an attenuated tumor-targeted bacteria, wherein the bacteria is a facultative aerobe or facultative anaerobe.

The Examiner further indicated that under 35 U.S.C. 121, upon election of an invention, further election of one of the following species is necessary:

- a. A specific bacteria strain, such as Salmonella;
- d. A specific chemotherapeutic agent;
- b. A specific first effector molecule while applicable;
- c. A specific second effector molecule while applicable'

Regarding (a), Applicants hereby elect Salmonella as a specific bacteria strain. Regarding (d), Applicants deem that a chemotherapeutic agent be considered as a single group. However, if the above does not convince the Examiner, Applicants choose Cisplatin as a specific chemotherapeutic agent. Regarding (b), Applicants hereby elect endostatin as a first effector molecule. Regarding (c), Applicants hereby elect BRP as a second effector molecule.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants : BERMUDEZ, et al.  
U.S. Serial No.: 10/738,423  
Filed : December 16, 2003  
Page : 5

No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,  
Albert Wai Kit Chan  
Albert Wai-Kit Chan  
Registration No. 36,479  
Attorney for Applicants  
Law Offices of  
Albert Wai-Kit Chan, LLC  
World Plaza, Suite 604  
141-07 20<sup>th</sup> Avenue  
Whitestone, New York 11357  
Tel: (718) 799-1000  
Fax: (718) 357-8615  
Email: chank@kitchanlaw.com